

Practitioner's Docket No. 604.30-US1

## CHAPTER II

Preliminary Classification:

Proposed Class:

Subclass:

TRANSMITTAL LETTER  
TO THE UNITED STATES ELECTED OFFICE (EO/US)

(ENTRY INTO U.S. NATIONAL PHASE UNDER CHAPTER II)

PCT/US00/07915	24 March 2000 (24.03.01)	None
International Application Number	International Filing Date	International Earliest Priority Date

TITLE OF INVENTION: INTERACTIVE COMMERCIALS AS INTERFACE TO A SEARCH ENGINE

APPLICANT(S): MINDARROW SYSTEMS, INC.; BLAKELEY, Thomas; and MCEWAN, Richard

Box PCT  
Assistant Commissioner for Patents  
Washington D.C. 20231

## CERTIFICATION UNDER 37 C.F.R. SECTION 1.10\*

(Express Mail label number is mandatory.)

(Express Mail certification is optional.)

I hereby certify that this paper, along with any document referred to, is being deposited with the United States Postal Service on this date May 21, 2001, in an envelope as "Express Mail Post Office to Addressee," mailing Label Number BL717614801US, addressed to the: Assistant Commissioner for Patents, Washington, D.C. 20231.

  
 Kristin J. Azcona

**WARNING:** Certificate of mailing (first class) or facsimile transmission procedures of 37 C.F.R. Section 1.8 cannot be used to obtain a date of mailing or transmission for this correspondence.

**\*WARNING:** Each paper or fee filed by "Express Mail" must have the number of the "Express Mail" mailing label placed thereon prior to mailing. 37 C.F.R. Section 1.10(b).  
 "Since the filing of correspondence under [Section] 1.10 without the Express Mail mailing label thereon is an oversight that can be avoided by the exercise of reasonable care, requests for waiver of this requirement will not be granted on petition." Notice of Oct. 24, 1996, 60 Fed. Reg. 56,439, at 56,442.

**ATTENTION: EO/US**

1. Applicant herewith submits to the United States Elected Office (EO/US) the following items under 35 U.S.C. Section 371:

- a. This express request to immediately begin national examination procedures (35 U.S.C. Section 371(f)).
- b. The U.S. National Fee (35 U.S.C. Section 371(c)(1)) and other fees (37 C.F.R. Section 1.492) as indicated below:

## 2. Fees

CLAIMS FEE*	(1) FOR	(2) NUMBER FILED	(3) NUMBER EXTRA	(4) RATE	(5) CALCULATIONS
	TOTAL CLAIMS	15 - 20 =	0	x \$18.00 =	\$0.00
	INDEPENDENT CLAIMS	2 - 3 =	0	x \$80.00 =	\$0.00
	MULTIPLE DEPENDENT CLAIM(S) (if applicable) + \$270.00				\$0.00
BASIC FEE	U.S. PTO WAS INTERNATIONAL PRELIMINARY EXAMINATION AUTHORITY Where an International preliminary examination fee as set forth in Section 1.482 has been paid on the international application to the U.S. PTO: and the international preliminary examination report states that the criteria of novelty, inventive step (non-obviousness) and industrial activity, as defined in PCT Article 33(2) to (4) have been satisfied for all the claims presented in the application entering the national stage (37 C.F.R. Section 1.492(a)(4)) ..... \$100.00				\$100.00
	Total of above Calculations				= \$100.00
SMALL ENTITY	Reduction by 1/2 for filing by small entity, if applicable. Affidavit must be filed. (note 37 CFR Sections 1.9, 1.27, 1.28)				- \$50.00
	Subtotal				\$50.00
	Total National Fee				\$50.00
	Fee for recording the enclosed assignment document \$40.00 (37 C.F.R. Section 1.21(h)). See attached "ASSIGNMENT COVER SHEET".				\$40.00
TOTAL	Total Fees enclosed				\$90.00

\*See attached Preliminary Amendment Reducing the Number of Claims.

A check in the amount of \$90.00 to cover the above fees is enclosed.

3. A copy of the International application as filed (35 U.S.C. Section 371(c)(2)) is not required, as the application was filed with the United States Receiving Office.
  4. A translation of the International application into the English language (35 U.S.C. Section 371(c)(2)) is not required as the application was filed in English.
  5. Amendments to the claims of the International application under PCT Article 19 (35 U.S.C. Section 371(c)(3)) are transmitted herewith.
  6. A translation of the amendments to the claims under PCT Article 19 (38 U.S.C. Section 371(c)(3)) is not required as the amendments were made in the English language.
  7. A copy of the international examination report (PCT/IPEA/409) is not required as the application was filed with the United States Receiving Office.
  8. Annex(es) to the international preliminary examination report is/are not required as the application was filed with the United States Receiving Office.
  9. A translation of the annexes to the international preliminary examination report is not required as the annexes are in the English language.
  10. An oath or declaration of the inventor (35 U.S.C. Section 371(c)(4)) complying with 35 U.S.C. Section 115 is submitted herewith, and such oath or declaration is attached to the application.
- II. Other document(s) or information included:
11. An International Search Report (PCT/ISA/210) or Declaration under PCT Article 17(2)(a) is not required, as the application was searched by the United States International Searching Authority.
  12. An Information Disclosure Statement under 37 C.F.R. Sections 1.97 and 1.98 will be transmitted within THREE MONTHS of the date of submission of requirements under 35 U.S.C. Section 371(c).
  13. An assignment document is transmitted herewith for recording.
  14. Additional documents:
    - a. Copy of request (PCT/RO/101)
  15. The above items are being transmitted before 30 months from any claimed priority date.

**AUTHORIZATION TO CHARGE ADDITIONAL FEES**

The Commissioner is hereby authorized to charge the following additional fees that may be required by this paper and during the entire pendency of this application to Account No.: 500341

37 C.F.R. Section 1.492(a)(1), (2), (3), and (4) (filing fees)

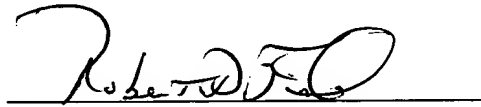
37 C.F.R. Section 1.492(b), (c), and (d) (presentation of extra claims)

37 C.F.R. Section 1.17 (application processing fees)

37 C.F.R. Section 1.17(a)(1)-(5) (extension fees pursuant to Section 1.136(a))

37 C.F.R. Section 1.492(e) and (f) (surcharge fees for filing the declaration and/or filing an English translation of an International Application later than 20 months after the priority date).

Date: May 21, 2001



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**IN THE INTERNATIONAL BUREAU (WIPO)**

<b>International Application Number</b>	<b>International Filing Date</b>	<b>International Earliest Priority Date</b>
PCT/US00/07915	24 March 2000	None

Title of Invention: **Interactive Commercials As Interface To A Search Engine**  
Applicant: **MindArrow Systems, Inc.**

International Bureau of WIPO  
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1211 Geneva 20  
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**LETTER FOR PCT ARTICLE 19**  
**(PCT SECTION 205)**

1. Applicant herewith submits replacement sheets(s) number(ed) 6 - 7 to replace sheet(s) number(ed) 6 - 7 originally filed for this application.
2. In respect of each claim appearing in the international application based on the replacement sheets submitted herewith, and in accordance with PCT Section 205, the following claim(s) is/are:
  - (i) unchanged: claim(s) 2-14
  - (ii) cancelled: claim(s) 0
  - (iii) new: claim(s) 0
  - (iv) replacement of one or more claims as filed, as follows: 1,15
  - (v) the result of the division of one or more claims as filed, as follows: 0

Dear Sir:

The Search Report dated 15 September 2000 designated 4 references as being relevant to patentability. In response, Claims 1 and 15 have been revised. The revised claims and references are addressed below seriatim.

**Revised Claim 1**

1. An interactive electronic commercial sent to a recipient as an attachment to an e-mail, comprising:  
a commercial message portion that includes a first branding graphic;  
an interface portion that receives a search string designated by the recipient; and  
a searching routine that submits the search string to a search engine, and returns results to the recipient from within an e-mail client, without using a browser.

**Revised Claim 15**

15. A method of sending an interactive electronic commercial to a recipient as an attachment to an e-mail, comprising:  
providing the commercial with a commercial message portion that includes a first branding graphic;  
the recipient opening the attachment;  
the opened attachment displaying an interface portion that receives a search string designated by the recipient;  
an e-mail client submitting the search string to a search engine [230]; and  
returning a set of results from submission of the search string to the recipient from within the e-mail client, without using a browser.

**Rosen et al. (Rosen) (US Patent 5995102)**

The Office considers claims 1-15 to be obvious over Rosen. The applicant disagrees, especially in view of the amendments herein. Rosen teaches against the claimed subject matter, and even if it didn't, Rosen fails to teach, suggest, or motivate one of ordinary skill in the field to arrive at the claimed subject matter.

**Rosen teaches against the claimed subject matter**

The presently amended claims all recite "...a searching routine that submits the search string to a search engine, and returns results to the recipient from within an e-mail client, without using a browser" or "...returning a set of results from submission of the search string to the recipient from within the e-mail client, without using a browser. In short, the claims require searching through an e-mail client without using a browser.

Rosen teaches against all of the pending claims because every embodiment contemplated by Rosen requires a browser. This is quite clear in Rosen's specification, which "requires [the use of] of a URL using an HTML-compliant client browser" (Rosen specification Col. 6 line 52-53). One corollary is that Rosen always uses a browser to (a) submit a search string and (b) retrieve a search result. That requirement is logically inconsistent with submitting a search string and retrieving a results without using a browser, as presently claimed.

A reference that teaches against the claimed subject matter can only be used to establish obviousness if there is something in the prior art that would have caused those skilled in the art to disregard the teachings of the reference in order to produce the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.* 721 F.2d 1540, 1552, 220 U.S.P.Q. 303, 314 (Fed. Cir. 1983), cert. Denied, 469 U.S. 851, 83 L. Ed. 2d 107, 105 S. Ct. 172 (1984). In order for a reference to cause one of ordinary skill in the art to disregard the teachings of the reference, there would have to be language in the reference or prior knowledge on the part of the skilled person that would lead to avoidance of the teachings of the reference. *W.L. Gore & Associates, Inc. v. Garlock, Inc.* supra. Neither the language of Rosen, nor any inference that can be drawn from it, nor any prior knowledge we know of would cause those skilled in the art to disregard the teachings of the reference. In fact, Rosen repeatedly emphasizes its requirement of a browser.

**Rosen fails to teach, suggest, or motivate**

Even if Rosen did not teach against the claimed inventions, there is nothing that teaches, suggests, or motivates one skilled in the art to provide a browser independent system, i.e. one in which a searching routine submits the search string to a search engine, and returns results to the recipient from within an e-mail client, without using a browser.

**Hirsch (US Patent 5978799)**

The Office considers claims 1-6, 8-10, and 15 to be obvious over Hirsch. The applicant disagrees, especially in view of the amendments herein.

**Hirsch teaches against the claimed subject matter**

Using the *W.L. Gore* case cited above as a guide, it is apparently that Hirsch also teaches against the pending claims. Among other things, Hirsch uses search strings that are

machine generated, (Hirsch specification Col 1 line 46-47), which is entirely inconsistent with search strings that are "designated by the recipient" as presently claimed. Moreover, there is nothing in the Hirsch reference that would cause one of ordinary skill in the art to disregard that inconsistency.

**Hirsch fails to teach, suggest, or motivate**

Even if Hirsch didn't teach against the pending claims, Hirsch is not a proper obviousness reference because it fails to teach, suggest, or motivate one of ordinary skill in the field to receive "a search string designated by the recipient [and to submit that] search string to a search engine", as claimed.

**Altia Inc. (Altia)**

The Office considers claims 1, 7, and 12-15 to be obvious over Altia. The applicant again disagrees, especially in view of the amendments herein.

Altia teaches an electronic form of advertising that lets the local television or radio station's audiences send and receive animated and interactive e-mail advertisements. Nowhere, however, does Altia teach, suggest, or motivate one of ordinary skill to use e-mail as a vehicle for receiving and submitting "a search string designated by the recipient [and to submit that] search string to a search engine", as claimed.

**E-Mail Marketing for the Roofing Contractor (E-Mail)**

The Office considers claims 1, and 9-15 to be obvious over E-Mail. The applicant again disagrees, especially in view of the amendments herein. As with several of the other references, E-Mail teaches against the claimed subject matter, and even if it didn't, E-Mail fails to teach, suggest, or motivate one of ordinary skill in the field to arrive at the claimed subject matter.

**E-Mail teaches against the claimed subject matter**

The present claims all contain the limitation of submitting "a search string designated by the recipient [and to submit that] search string to a search engine without using a browser." E-Mail teaches against the pending claims because all contemplated embodiments require a browser. Doing something "without using a browser" is inconsistent with doing something that requires a browser.



**E-Mail fails to teach, suggest, or motivate**

Even if E-Mail did not teach against the claimed inventions, there is nothing that teaches, suggests, or motivates one skilled in the art to develop a system in which a searching routine submits the search string to a search engine, and returns results to the recipient from within an e-mail client, without using a browser, as presently claimed.

**Combinations**

There is no combination of references that renders the pending claims obvious.

First of all, there is no motivation to combine the references to pull one of the claimed elements from one reference and other elements from other references. Any such combination would be pure hindsight, which is improper. See, for example, *In re Chu*, 66 F.3d 292, 298, 36 U.S.P.Q.2D (BNA) 1089, 1094 (Fed. Cir. 1995) (stating that even when changes from the prior art are "minor" or "simple," an inquiry must be made as to whether "the prior art provides any teaching or suggestion to one of ordinary skill in the art to make the changes" (quoting *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 935, 15 U.S.P.Q.2D (BNA) 1321, 1324 (Fed. Cir. 1990))).

And second, even if one did selectively pull elements from all the references, they still wouldn't arrive at the claimed limitations. There is no teaching, suggestion, or motivation to arrive at submitting "a search string designated by the recipient [and to submit that] search string to a search engine without using a browser." The present claims are just not obvious over the cited art.

Respectfully submitted,



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